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EXAMINER

VENKAT, JYOTHSNA A

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1615

DATE MAILED: 10/02/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary*Applicant's copy*

Application No.

09/902,660

Applicant(s)

JEANNE-ROSE ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-49 (all in part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using organometallic compound obtained from a precursor where in the precursor is formula Ia, classified in class 424, subclasses 61,70.1+, and 401.
 - II. Claim1-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula Ib, classified in class 424, subclasses 61,70.1+, and 401.
 - III. Claim1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula Ic, classified in class 424, subclasses 61,70.1+, and 401.
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- IV. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula Id, classified in class 424, subclasses 61,70.1+, and 401.
- V. Claim 1-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IIa, classified in class 424, subclasses 61,70.1+, and 401.
- VI. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IIb, classified in class 424, subclasses 61,70.1+, and 401.
- VII. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic
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compound obtained from a precursor where in the precursor is formula IIc, classified in class 424, subclasses 61,70.1+, and 401.

VIII. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IId, classified in class 424, subclasses 61,70.1+, and 401.

IX. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IIIa, classified in class 424, subclasses 61,70.1+, and 401.

X. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IIIb, classified in class 424, subclasses 61,70.1+, and 401.

XI. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up

composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IIIc, classified in class 424, subclasses 61,70.1+, and 401.

XII. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IIId, classified in class 424, subclasses 61,70.1+, and 401.

XIII. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IVa, classified in class 424, subclasses 61,70.1+, and 401.

XIV. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IVb, classified in class 424, subclasses 61,70.1+, and 401.

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- XV. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IVc, classified in class 424, subclasses 61,70.1+, and 401.
- XVI. Claim 1-21, 23-49 (all in- part) are, drawn to method of protecting and /strengthening keratin material, a composition in the form of make-up composition, a nail varnish, a nail base, a nail care product, or a hair –care product and a process for treating a keratin material using an organometallic compound obtained from a precursor where in the precursor is formula IVd, classified in class 424, subclasses 61,70.1+, and 401.

The inventions are distinct, each from the other because of the following reasons:

Groups I and II are to different methods. The methods are different because they use different metal precursors. In group I the metal precursor is attached to the moiety **OR₁** where as in group II the metal is attached to **OR₁** and also **R**. Additionally each R group is drawn to different moieties and are structurally different. Therefore groups I and II have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group II. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

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Groups I and III are to different methods. The methods are different because they use different metal precursors. In group I the metal precursor is attached to the moiety OR_1 where as in group III the metal is attached to **two** OR_1 and also R'' . Additionally the *definition for R_1 is different than R'' group* and, therefore, both the groups are structurally different. Therefore groups I and III have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group III. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and IV are to different methods. The methods are different because they use different metal precursors. In group I the metal precursor is attached to the moiety OR_1 where as in group IV the metal is attached to OR_1 and R , and R'' . Additionally the *definition for R_1 is different than R'' group* and, therefore, both the groups are structurally different. Therefore groups I and IV have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group IV. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and V are to different methods. The methods are different because they use different metal precursors. In group I the **metal precursor is a metal alkoxide** where as in group V the **metal is a complex** attached to OR_1 and X . Additionally the *definition for R_1 is different than the ligand X* and, therefore, both the groups are structurally different. Therefore groups I and V have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group V. The different methods require completely

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different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and VI are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **VI** the metal is attached to **ligand X, OR₁** and also **R**. Additionally each R group is drawn to different moieties and are structurally different. Therefore groups I and IV have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group VI. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and VII are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **VII** the metal is attached to **ligand X, two OR₁** and also **R''**. Additionally the *definition for R₁ is different than R'' group* and, therefore, both the groups are structurally different. Therefore groups I and VII have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group VII. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and VIII are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **VIII** the metal is attached to **ligand X, OR₁** and **R**, and **R''**. Additionally the *definition*

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for R₁ is different than R'' group and, therefore, both the groups are structurally different.

Therefore groups I and VIII have different issues regarding patentability and enablement issues.

Art anticipating group I would not anticipate or render obvious group VIII. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and IX are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **IX** the metal is attached to **HALOGEN**. Additionally each R group is drawn to different moieties and are structurally different. Therefore groups I and IX have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group IX. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and X are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **X** the metal is attached to **HALOGEN** and also **R** therefore, both the groups are structurally different. Therefore groups I and X have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group X. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

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Groups I and XI are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **XI** the metal is attached to **two HALOGENS** and also **R''**. Additionally the *definition for R₁ is different than R'' group* and, therefore, both the groups are structurally different.

Therefore groups I and XI have different issues regarding patentability and enablement issues.

Art anticipating group I would not anticipate or render obvious group XI. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and XII are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **XII** the metal is attached to **HALOGEN, R, and R'**. Additionally the *definition for R₁ is different than R' group* and, therefore, both the groups are structurally different. Therefore groups I and XII have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group XII. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and XIII are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **XIII** the metal is attached to **HALOGEN, and a LIGAND**. Additionally each R group is drawn to different moieties and are structurally different. Therefore groups I and XIII have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group XIII. The different methods require completely different

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searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and XIV are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **XIV** the metal is attached to **HALOGEN, LIGAND** and also **R**, therefore, both the groups are structurally different. Therefore groups I and XIV have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group XIV. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and XV are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **XV** the metal is attached to **two LIGANDS, two HALOGENS, ANOTHER metal** and also **R''**. Additionally the *definition for R₁ is different than R'' group* and, therefore, both the groups are structurally different. Therefore groups I and XV have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group XV. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Groups I and XVI are to different methods. The methods are different because they use different metal precursors. In group **I** the metal precursor is attached to the moiety **OR₁** where as in group **XVI** the metal is attached to **HALOGEN, LIGAND, R, and R'**. Additionally the

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definition for R_I is different than R'group and, therefore, both the groups are structurally different. Therefore groups I and XVI have different issues regarding patentability and enablement issues. Art anticipating group I would not anticipate or render obvious group XVI. The different methods require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. This creates an undue search burden.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-XVI, restriction for examination purposes as indicated is proper.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Currently, claims 1,44,45,and 48 are generic.

4. *Election of species:*

If applicant elects any of the above groups, applicant is required to elect from the following patentably distinct species.

SUBGRIOUP I: Species of metal

1) Group Ib metals

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- 2) Group IIb metals
- 3) Group IIIb metals
- 4) Group IVb metals
- 5) Group VIb metals
- 6) Group VIIb metals
- 7) Group VIII of the periodic table
- 8) Lanthanide group
- 9) Aluminum
- 10) Silicon
- 11) Boron
- 12) Tin
- 13) Magnesium
- 14) Alkaline metals
- 15) Alkaline-earth metals

The species are different because their valences are different and the reactivities are different and because of their differences, they are classified in the periodic table as different groups. Some of them are metals and some of them are non-metals. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter. It is an undue burden to search among the different species.

If applicant elects groups V-VIII, or XII-XVI, they are further required to elect the ligand.

SUBGROUP II: Species of ligand

- 1) NITROGEN
- 2) PHOSPHOROUS
- 3) SULPHUR
- 4) OXYGEN

The species are different because the compounds attached to these atoms are different and the reactivities are different. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter. It is an undue burden to search among the different species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). Because the above restriction/election is complex, a telephone call to applicants to request an oral election was not made. See MPEP 812.01

1. Applicant is also reminded that a 1-month (not less than 30 days) shortened statutory period will be set for response when a written restriction is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the


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currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on M-F, 9:30-6:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 for regular communications and 703-308-7924 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615

September 30, 2002